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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

GROUP 3600

Application Number: 10/824,889
Filing Date: April 14, 2004
Appellant(s): WEXLER, TOBY

Robert N. Montgomery
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/16/07 appealing from the Office action mailed 01/03/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-7, 11, 14-17 and 27-39.

Claims 8-10, 12, 13 and 18-26 have been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

GROUND OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

Claims 32-39 are rejected under 35 U.S.C. 112, first paragraph.

Claims 1-7, 11, 14-17, 31, 37 are rejected under 35 U.S.C. 112, second paragraph.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Merriam-Webster's Collegiate Dictionary Tenth Edition, definition "delamination"

4,908,881	Field	3-1990
2,285,981	Johns	6-1942

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 5, 27, 28, 30, 32-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Field, US Patent 4,908,881.

Art Unit: 3644

Field discloses a polymeric sheath (44) having an opening (46) and an internal and external shape generally consistent with that of an animals toenail, the polymeric sheath comprising a second layer of polymer (48) encompassing at least a portion of the polymeric sheath (reference Figure 3).

Regarding Claims 2, 28 and 34, Field discloses the second layer of polymer is harder than that of the polymeric sheath (column 3, line 17 and column 3, lines 27-30).

Regarding claim 5, Field discloses that the second layer may be removable from the sheath thereby providing the sheath with the delamination between the sheath and the second layer of polymer.

Regarding claim 30, Field discloses the coating is applied to the sheath.

Regarding claims 32 and 33, Field discloses the covering having a non-uniform wall thickness having a greater thickness at the distal end than at the proximate end (as viewed in Figure 3) wherein the non-uniform wall thickness is a lamination of layers.

Regarding claim 35, Field discloses a void (50) located between the layers.

Claims 3, 6, 7, 14-17, 29, 36 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field, US Patent 4,908,881.

Regarding claims 3, 29 and 36, Field discloses the invention as claimed. However, Field does not positively disclose that the second layer of polymer is a different color than the polymeric sheath. Field does disclose that the second layer may be prepared in various colors and designs for aesthetic purposes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a sheath of differing color than the second

Art Unit: 3644

polymer layer so as to provide more contrast and thereby add to the aesthetic nature of the device.

Regarding claim 6, Field discloses that the second polymer layer is mounted to the sheath. While not positively stating that an adhesive element is used, it would have been obvious to one having ordinary skill in the art that such an adhesive element must be present as there is no structural mechanism in which to retain the second polymer layer onto the sheath.

Regarding claims 7, 14 and 15, while Field suggests the use of an adhesive, the type of adhesive to be used is not disclosed. However, it is evident from the structure that the adhesive to provide the mounting of (48) at (50) must be located between the polymeric sheath and the second layer of polymer. One of skill in the art would consider the use of a liquid adhesive, a powered adhesive or an aerosol adhesive as a matter of obvious routine choice of design rather than constitute a patentably distinct inventive step barring a convincing showing of evidence to the contrary.

Regarding claims 16 and 17, the process of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. These are product-by-process claims.

Regarding claim 38, Field discloses the invention substantially as claimed. However, Field does not disclose the opening into the cavity to be rectangular. It would have been an obvious matter of design choice to use any shaped opening consistent with the appendage on which the device is to be placed, since applicant has not disclosed that the rectangular opening solves any stated problem or is for any particular purpose (as the shape has not been discussed

Art Unit: 3644

within the specification) and it appears that the invention would perform equally well with any shaped opening so as to be snugly fit on the appendage of the wearer.

Regarding claim 39, Field discloses the overlay is a different material composition than the sheath.

Claims 4, 11, 31 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field as applied to claim 1 above, and further in view of Johns, US Patent 2,285,981.

Regarding claims 4, 31 and 37 as best understood, Field discloses the invention substantially as claimed. However, Field does not disclose the use of internal cleats. Johns teaches within the same field of endeavor the use of internal cleats (7) for preventing the sheath from slipping off. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cleats as taught by Johns with the device of Field in order to maintain the sheath in the correct position.

Regarding claim 11, Fields as modified per the discussion above provides for a textured inner wall surface.

(10) Response to Argument

Rejection of Claim 1, under 35 U.S.C. 102(b) as being anticipated by Field, US Patent 4,908,881.

With respect to the Appellant's arguments regarding *Field* not being a proper reference as it comes from a non-analogous art. The question of whether a reference is analogous art is not relevant to whether the reference anticipates. A reference may be directed to an entirely different problem than the one addressed by the inventor, or may be from an entirely different field of

Art Unit: 3644

endeavor than that of the claimed invention, yet the reference is still anticipatory if it explicitly or inherently discloses every limitation recited in the claims. MPEP 2131.05

The Appellant continually argues the equivalency between a human finger and that of an animal toenail. It is noted that the claim merely requires the sheath to have a shape “generally consistent with that of an animal’s toenail.” The Appellant argues that an animal toe nail is triangular shaped at its proximal end, tapering and curving to a point at its distal end. However, no such recitation of this feature has been claimed. As such, the Examiner maintains the position that the *Field* reference discloses a covering having a shape that is generally consistent with that of an animal’s toenail, inclusive, but not limited to animals such as grizzly bears that have claws generally consistent with the shape of a human finger. Further, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is maintained that the sheath of *Field* is capable of being used as a covering for an animal toenail and as such, anticipates the claim.

With respect to the Appellant’s argument regarding the amendment to the claims such that the claim was limited to “claws” by amendment, no such amendment has been entered and no such claim limitation is currently under Appeal.

With respect to the Appellant’s arguments regarding the *Field* reference not disclosing a second layer of polymer covering at least a portion of the sheath, the Examiner maintains that the sheath of *Field* includes a second layer (48) covering at least a portion of the sheath (reference Figure 3 of the *Field* reference). The Appellant further argues that the toenail sheath of the

Art Unit: 3644

instant application is a single piece with no removable attachments, it is respectfully submitted that no such claim limitation has been presented and as such the Appellant's arguments are not specific to the invention as claimed.

With respect to the Appellant's arguments regarding the toenail sheath being made of cloth, no such recitation was read into the interpretation of the claims and as such the Appellant's arguments with respect to a sheath made of cloth are considered spurious and not germane to the issues currently under appeal.

Rejection of Claim 2, under 35 U.S.C. 102(b) as being anticipated by Field, US Patent 4,908,881.

With respect to the Appellant's argument regarding the *Field* reference not disclosing the external coating having a hardness greater than that of the polymeric sheath. In interpreting the *Field* reference, the external coating is the decorative artificial fingernail. The *Field* reference clearly discloses that the artificial fingernail (external coating) is made of a rigid plastic and that the sheath is made of a semi-pliable material. The Examiner maintains that a disclosure of a rigid plastic (i.e. a plastic which does not yield) and a sheath made of a semi-pliable material (i.e. a material which is designed to yield and have a degree of pliability) does in fact inherently disclose the claim limitation of the external coating having a hardness greater than that of the polymeric sheath.

With respect to the Appellant's arguments regarding "density." The amendment after final was not entered and as such, no claim limitation regarding density is under appeal. No further discussion regarding this argument is deemed necessary.

Rejection of Claim 3, under 35 U.S.C. 103(a) as being unpatentable by Field, US Patent 4,908,881.

It is first noted that claim 3 was rejected under 35 USC 103(a) as being non-obvious over the prior art. With respect to the Appellant's arguments regarding the *Field* reference making no mention that the sheath and nail should be different colors, it is clearly pointed out in the *Field* disclosure that the nail covering can be made in various colors (column 3, lines 27-29). As such, the reference provides motivation for one with skill in the art to use a different color for the nail covering than that of the sheath to provide greater aesthetics to the apparatus. As the *Field* reference does reasonably provide for an embodiment in which the nail and sheath are made of the same color, Claim 3 was rejected under 35 U.S.C. 103(a) as while not being necessarily anticipatory of the claim, the reference provides a basis for the claim limitation (i.e. the difference in color) to be an obvious variant within the skill of an artisan in the art.

Rejection of Claim 4, under 35 U.S.C. 103(a) as being unpatentable over Field, US Patent 4,908,881 in view of Johns, US Patent 2,285,981.

In response to Appellant's argument that the *Johns* reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the *Johns* reference is directed to a sheath containing internal cleats for maintaining the sheath in its intended position during use and as such, it is maintained that the *Johns* reference is an analogous art reference to that of

Art Unit: 3644

Field. The Examiner also maintains that any wall surface other than a specifically stated smooth wall is inclusive of a texture and thereby meets the claim limitation.

Rejection of Claims 4 and 11, under 35 U.S.C. 103(a) as being unpatentable over Field, US Patent 4,908,881 in view of Johns, US Patent 2,285,981.

With respect to the Appellant's arguments, it is maintained that the *Field* reference discloses the invention as claimed in claim 1. However, as was stated in the rejection, the *Field* reference does not disclose that which was claimed in claims 4 and 11 and as such, a rejection under 35 U.S.C. 103(a) was made using the teaching reference of *Johns*. The argument is deemed spurious as to not being directed to any specific claim limitation.

Rejection of Claim 5 under 35 U.S.C. 102(b) as being anticipated by Field, US Patent 4,908,881.

With respect to the Appellant's arguments regarding claim 5, the Examiner maintains that the detachable fingernail of the *Field* finger sheath to be a polymeric coating and that the separation of the fingernail from the sheath constitutes a delamination. As is provided by the Evidence regarding the definition of "delamination", a "delamination" is defined to be a "separation into constituent layers". As the sheath of *Field* and the attached fingernail constitute separate constituent layers of the apparatus, it is maintained that *Field* anticipates the claim limitation.

Rejection of Claim 6 under 35 U.S.C. 103(a) as being anticipated by Field, US Patent 4,908,881.

With respect to the Appellant's arguments regarding claim 6, the Appellant states that it "may be possible that the fingernail has a weak adhesive backing." Such an admission supports

Art Unit: 3644

the Examiner's contention that one with ordinary skill in the art would find it obvious that an adhesive element must be present to retain the second polymer layer onto the sheath. The Appellant further argues that the artificial fingernail is simply decorative and is not an essential element of the sheath. As the *Field* reference discloses the nail in combination with the sheath, the statement regarding the essential nature of such an element is immaterial as the element is positively disclosed and therefore, the elements of the apparatus are considered as a whole thereby meeting the claim limitations.

Rejection of Claim 7 under 35 U.S.C. 103(a) as being anticipated by Field, US Patent 4,908,881.

The Appellant argues that a possibly weak adhesive applied to a removable decoration and an adhesive injected between two adjacent layers of the Appellant's toenail sheath is not a logical comparison. It is maintained that it is obvious through the disclosure of the *Field* reference that an adhesive is used to mount the fingernail onto the sheath thereby meeting the claim limitation of the adhesive element being inserted between the polymeric sheath and the external coating polymer. The Examiner further maintains that it is well within the skill of an artisan in the art to choose any known adhesive element for the attachment of the coating to the sheath, as the Appellant has not argued any criticality to the type of adhesive to be used. Attorney argument in a brief cannot take the place of evidence. In re Pearson, 494 F. 2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

Rejection of Claim 11, under 35 U.S.C. 103(a) as being unpatentable over Field, US Patent 4,908,881 in view of Johns, US Patent 2,285,981.

The Appellant argues that the inner wall surface as taught by *Johns* does not constitute a textured surface. The Examiner maintains that proper motivation was used to combine the *Field* and *Johns* reference relied upon for the rejection of claim 11 and as *Johns* clearly discloses a surface which is not smooth, i.e. as is seen in Figure 2 within the internal wall of the sheath, it must therefore be textured.

Rejection of Claims 14-17, under 35 U.S.C. 103(a) as being unpatentable over Field, US Patent 4,908,881 in view of Johns, US Patent 2,285,981.

With respect to claims 14-17, the Appellant argues that the *Field* reference does not disclose an adhesive powder or an aerosol adhesive. It is maintained that it is obvious through the disclosure of the *Field* reference that an adhesive is used to mount the fingernail onto the sheath thereby meeting the claim limitation of the adhesive element being inserted between the polymeric sheath and the external coating polymer. The Examiner further maintains that it is well within the skill of an artisan in the art to choose any known adhesive element for the attachment of coating to the sheath as the Appellant has not argued any criticality to the type of adhesive to be used. Attorney argument in a brief cannot take the place of evidence. In re Pearson, 494 F. 2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

With respect to the product-by-process claims 16 and 17, “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.” MPEP 2113. As such, the manner in which the adhesive is applied to the sheath has no bearing on the functionality of the apparatus, i.e. irrespective of the manner in which the adhesive is applied; the adhesive is located between the polymer coating and the sheath. Therefore, it is maintained that the *Field* reference clearly suggests the use of an

Art Unit: 3644

adhesive between the polymer coating and the sheath and the method in which the Appellant applies the adhesive has no defining characteristics upon the product itself.

Rejection of Claims 27, 28, 30 and 32-35 under 35 U.S.C. 102(b) as being anticipated by Field, US Patent 4,908,881.

With respect to the Appellant's arguments regarding case law requiring the Examiner to identify where the prior art provides a motivating suggestion for the disclosed modification and combinations. It is noted that the claims were rejected under 35 U.S.C. 102(b) as being anticipated by the prior art reference and as such, no motivation is required to modify the prior art reference.

With respect to the Appellant's arguments regarding the Examiner making the assumption that the sheath surrounding a whole human finger is equivalent to a sheath only surrounding an animal's toe nail. The Appellant is arguing intended use of the apparatus and has not clearly pointed out or distinctly argued any claim limitation which would preclude the apparatus from being used in such a manner.

With respect to the Appellant's arguments regarding the use of a plastic as a polymer. The Appellant has provided a dictionary definition of the terminology which has not been properly submitted into evidence and therefore such statements should not be relied upon. However, the Appellant has stated that in the instant case, the polymeric is used in the form of a polyvinyl chloride dip. The Examiner notes that polyvinyl chloride is a thermoplastic and as such, it is maintained that given the Appellants disclosure in the instant application and the arguments provided, that a plastic is maintained as a polymer and therefore the *Field* reference is maintained as being anticipatory over the instant claim limitations.

With respect to the Appellant's argument regarding claim 27 and the *Field* reference not disclosing the polymer encompassing a portion of the sheath, the Examiner maintains that the portion of the sheath which is underlying the fingernail of the *Field* reference is encompassing a portion of the sheath.

With respect to the Appellant's statement regarding claims 28 and 34 regarding the *Field* reference disclosing the coating being made of a rigid plastic and the sheath being made of a semi-pliable material indicating that the nail must be somehow harder than the sheath; the Examiner maintains that a disclosure of a rigid plastic in relation to a semi-pliable material does in fact disclose the rigid plastic (i.e. the coating) being harder than the semi-pliable material (the sheath).

The Appellant again argues with respect to claim 30 that the *Field* reference does not disclose a coating applied to the sheath. It is again maintained that the fingernail as disclosed by *Field* is in fact a coating which encompasses a portion of the sheath thereby meeting the claim limitations.

Regarding claims 32 and 33, it is respectfully submitted the Examiner has not ignored the claim limitation defining a non-uniform wall thickness having a greater thickness at its distal end than its proximal end. As is clearly seen in the illustration of Figure 3, a void is provided at (50) within the sheath for placement of a fingernail and as such, such a void clearly defines a non-uniform wall thickness.

With respect to the argument of claim 32 with respect to the telescopically encasing of an animal toenail. It is noted that a rejection under 35 U.S.C. 112, first and second paragraph was made with respect to such limitation. As the Appellant has not argued the rejections under 35

Art Unit: 3644

U.S.C. 112, first and second paragraph, the argument under 35 USC 102(b) is considered moot with respect to the telescopic encasement of the animal toenail. It is noted that the Appellant is again relying on a definition of a term which has not been submitted into evidence and which is not so defined within the specification as to be clear and concise to one with skill in the art.

Claims 29, 36 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field, US Patent 4,908,881. Claims 31 and 37 are further rejected as being unpatentable over Field in view of Johns, US Patent 2,285,981.

With respect to the arguments regarding claims 29 and 36, please reference arguments regarding claim 3, above.

With respect to claims 31 and 37, the Examiner maintains that the *Johns* reference, through the disclosure of internal cleats having a rising slope adjacent to a descending slope thereby defines an anticline cleats within the structure. The Appellant argues that the anticline cleats do not encircle the sheath in the manner disclosed by *Johns*. Such a statement supports the Examiner's contention that the *Johns* reference discloses the use of anticline cleats. Further, it is noted that the Appellant has not claimed a "row" of anticline cleats along one side of the sheath and as such, the Appellant's arguments are more specific than the claim limitations allow for.

With respect to the argument regarding claim 38, these remarks are considered merely argumentative and do not address the rejection of record. As such, the Examiner maintains the rejection of record as it is noted that the shape of the opening has not been addressed within the specification of the application and therefore has been provided no criticality such that one with skill in the art would not find it obvious to shape the opening consistent with the appendage of the user. The Appellant is again arguing that the prior art does not disclose an apparatus which

Art Unit: 3644

conforms to a triangular shape however, it is again noted that no such limitation has been claimed.

With respect to the Appellant's arguments regarding "density," the amendment after final was not entered and as such, no claim limitation regarding density is under appeal. No further discussion regarding this argument is deemed necessary.


It is noted that the Appellant argues with respect to that which is shown and discussed but not to that which is claimed. It is the claim limitations which provide the metes and bounds of the claim and as such, it is maintained that the *Fields* reference discloses the Appellant's invention as claimed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Kimberly S. Smith

Conferees:

Meredith Petravick

Robert Swiatek 